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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/614,056

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Takeshi Ando

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EXAMINER

HUYNH, CHUCK

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

06/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/614,056	<b>Applicant(s)</b> ANDO, TAKESHI	
	<b>Examiner</b> Chuck Huynh	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-12 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 2/23/2007 has been entered.

### ***Response to Arguments***

1. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that Kung does not suggest the mode changing unit that change the mode of connection between a caller terminal and a mobile station from a conversation mode to a text-based mail sending mode upon receiving a request from a caller terminal.

Examiner respectfully disagrees, and would like to further point to column 38, lines 13-34, wherein Kung further discloses the fact that a caller making an audio mode call (conversation mode) to a called party, and pressing the relevant option to initiate a data call (changing to text-based mode) and sending an email to called user.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claim 1-2, 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toy et al. (hereinafter Toy; US 6192115) in view of Koster (US 6259914) further in view of Kung et al. (US 6373817; hereinafter Kung).**

Regarding claim 1, Toy discloses a notification system for notifying information about a mobile station capable of using international roaming service (Abstract; Col 2, lines 9-10), comprising:

an information storing unit (databases Fig.1 , nos. 22,23) that stores information about a mobile station which belongs to a first network in a first country, said information including a fact whether said mobile station is moved to a second country and registered as a visitor station in said second country or not (Col 1, lines 41-53; Col 2, lines 1-26; Col 3, lines 51-52));

a notification unit (Col 3, lines 53-58) that refers to said information storing unit when said mobile station is called by a caller terminal within said first network to detect whether said mobile station is registered as said visitor station in said second country or not, and notifies said caller terminal of the registration

Art Unit: 2617

of said mobile station before a connection between said caller terminal<sup>15</sup> and said mobile station is established, when said mobile station is registered as said visitor station in said second country (Col 2, lines 16-26).

a location obtaining unit that obtains location of said mobile station (Col 2, lines 16-26);

a visitor registration unit that registers said mobile station as a visitor station in said second country to have said mobile station capable of establishing a connection via a second network in said second country when said mobile station moves to said second country and requests for the registration (Col 2, lines 16-26);

a reporting unit that reports said registration of said mobile station to said location obtaining unit, wherein said location obtaining unit stores information about said registration of said mobile station in said information storing unit (Col 2, lines 16-26; Col 5, lines 37-40); and

a retaining unit that temporary retains establishing a connection between said caller terminal and said mobile station (holding for information before making/completing the call Col. 2, lines 1-6; 43-47).

Toy discloses all the particulars of the claim, but was unclear on the international roaming aspect (Col 2, lines 1-15).

However, Koster does disclose international roaming services (Abstract) and an HLR and a VLR to conduct registration.

It would have been obvious to one ordinarily skilled in the art at the time of invention to combine Toy's disclosure with Koster to provide international

Art Unit: 2617

(country to country) registration information for caller of called party to establish calling charges, for improved billing accuracy.

Toy in view of Koster discloses all the particulars of the claim except for a mode changing unit that changes mode of a connection between said caller terminal and said mobile station from a conversation mode to a text-based mail sending mode upon receiving a request from said caller terminal,

wherein if said mode changing unit that changes from the conversation mode to the text-based mail sending mode upon receiving the request from said caller terminal, the notification system allows said caller terminal to send a text-based mail message to said mobile station.

However, Kung does disclose a mode changing unit that changes mode of a connection between said caller terminal and said mobile station from a conversation mode to a text-based mail sending mode upon receiving a request from said caller terminal (Col 10, lines 57-63; furthermore, Col 38, lines 13-34),

wherein if said mode changing unit that changes from the conversation mode to the text-based mail sending mode upon receiving the request from said caller terminal, the notification system allows said caller terminal to send a text-based mail message to said mobile station (Col 38, lines 13-34).

It would have been obvious to one ordinarily skilled in the art at the time of invention to be able to send text-base messages instead of talking to the called party if parties are not simultaneously available.

Regarding claim 2, Toy discloses a notification system as set forth in Claim 1, further comprising a calculating unit that calculates telephone fee charged to said caller terminal when said connection between said caller terminal and said mobile station registered as said visitor station in said second country is established, wherein said notification unit notifies said caller terminal of the telephone fee calculated by said accounting unit in addition to said registration before said connection between said caller terminal and said mobile station is established, when said mobile station 10 is registered as a visitor station in said second country (Abstract; Col 1, lines 41-53; Col 2, lines 1-15).

Regarding claim 4, Toy discloses a notification system as set forth in claim 2 further comprising:

a location obtaining unit that obtains location of said mobile station (Col 2, lines 16-26);

a visitor registration unit that registers said mobile station as a visitor station in said second country to have said mobile station capable of establishing a connection via a second network in said second country when said mobile station moves to said second country and requests for the registration (Col 2, lines 16-26); and

a reporting unit that reports said registration of said mobile station to said location obtaining unit, wherein said location obtaining unit stores information

Art Unit: 2617

about said registration of said mobile station in said information storing unit (Col 2, lines 16-26; Col 5, lines 37-40).

Regarding claim 5, Toy discloses a notification system as set forth in claim 3, wherein said visitor registration unit deletes said registration of said mobile station as said visitor station upon receiving request from said mobile station, said reporting unit reports said deletion of said registration of said mobile station to said location obtaining unit, and said location obtaining unit deletes said information about said registration information in said information storing unit (Col 2, lines 16-38).

Regarding claim 6, Toy discloses a notification system as set forth in claim 4, wherein said visitor registration unit deletes said registration of said mobile station as said visitor station upon receiving request from said mobile station, said reporting unit reports said deletion of said registration of said mobile station to said location obtaining unit, and said location obtaining unit deletes said information about said registration information in said information storing unit (Col 2, lines 16-38).

Regarding claim 7, Toy discloses a notification system as set forth in claim 1, further comprising an accounting unit that charges paid caller terminal for notification of said notification unit (Col 2, lines 56-59).



Art Unit: 2617

Regarding claim 8, Toy discloses a notification system as set forth in Claim 2, further comprising an accounting unit that charges said caller terminal for notification of said notification unit (Col 2, lines 56-59).

3. Claim 9, 10, are rejected under 35 U.S.C. 103(a) as being *and* unpatentable over Toy in view of Koster further in view of Kung, *in* further view of Dunn.

Regarding claim 9, Toy in view of Koster in further view of Kung discloses all the particulars of the claim except for a notification system as set forth in claim 1, further comprising a time calculation unit that calculates local time of said second country, wherein said notification unit notifies said caller terminal of said local time in addition to said registration, when said mobile station is registered as a visitor station in said second country.

However, Dunn does disclose a notification system as set forth in claim 1, further comprising a time calculation unit that calculates local time of said second country, wherein said notification unit notifies said caller terminal of said local time in addition to said registration, when said mobile station is registered as a visitor station in said second country (Abstract; Col 2, lines 18-30; Col 3, lines 43-45, 49-51).

It would have been obvious to one ordinarily skilled in the art at the time of invention to incorporate Dunn's feature with Toy to provide users with more

Art Unit: 2617

information options, so that caller may exercise better judgment and be better informed of called party circumstances.

Regarding claim 10, Toy in view of Koster in further view of Kung discloses all the particulars of the claim except for a notification system as set forth in claim 2, further comprising a time calculation unit that calculates local time of said second country, wherein said notification unit notifies said caller terminal of said local time in addition to said registration, when said mobile station is registered as a visitor station in said second country.

However, Dunn does disclose a notification system as set forth in claim 1, further comprising a time calculation unit that calculates local time of said second country, wherein said notification unit notifies said caller terminal of said local time in addition to said registration, when said mobile station is registered as a visitor station in said second country (Abstract; Col 2, lines 18-30; Col 3, lines 43-45; 49-51).

It would have been obvious to one ordinarily skilled in the art at the time of invention to incorporate Dunn's feature to provide users with more information options, so that caller may exercise better judgment and be better informed of called party circumstances.

Art Unit: 2617

4. Claim 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toy in view of Koster further in view of Kung <sup>and</sup> in further view of Asano et al. (hereinafter Asano).

Regarding claim 11, Toy in view of Koster in further view of Kung discloses all the particulars of the claim except a notification system as set forth in claim 1, further comprising a translation unit that aids translation of conversations between users of said caller terminal and said mobile station.

However, Asano does disclose a notification system as set forth in claim 1, further comprising a translation unit that aids translation of conversations between users of said caller terminal and said mobile station (Col 5, lines 64-67; Col 6, lines 1-13).

It would have been obvious to one ordinarily skilled in the art at the time of invention to incorporate a translation unit to facilitate communication between different language users.

Regarding claim 12, Toy in view of Koster in further view of Kung discloses all the particulars of the claim except a notification system as set forth in claim 2, further comprising a translation unit that aids translation of conversations between users of said caller terminal and said mobile station.

However, Asano et al. (hereinafter Asano) does disclose a notification system as set forth in claim 1, further comprising a translation unit that aids translation of conversations between users of said caller terminal and said mobile station (Col 5, lines 64-67; Col 6, lines 1-13).

Art Unit: 2617

It would have been obvious to one ordinarily skilled in the art at the time of invention to incorporate a translation unit to facilitate communication between different language users.

**5. Claim 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koster in view of Frey et al. (US 6535596; hereinafter Frey) further in view of Kung et al. (US 6373817; hereinafter Kung).**

Regarding claim 17, Koster discloses a notification system for notifying information about a mobile station capable of using an international roaming service, comprising:

an information storing unit that stores information about a mobile station which belongs to a first network in a first country, said information including a fact whether said mobile station is moved to a second country and registered as a visitor station in said second country or not (Abstract);

a visitor registration unit for registering said mobile station as a visitor station in said second country so as to have said mobile station be capable of establishing a connection via a second network in said second country when said mobile station moves to said second country and requests the registration, the visitor registration unit being part of the second network in the second country (Abstract);

a reporting unit for reporting said visitor registration of said mobile station to said location obtaining unit, the location obtaining unit storing information

Art Unit: 2617

about said visitor registration in said information storing unit (Fig. 1; Col 4, lines 48-65);

Koster discloses all the particulars of the claim except for  
a notification unit for referring to said information storing unit to detect,  
when said mobile station is called by a caller terminal within said first country,  
whether the mobile station is registered as a visitor station in the second country,  
and, if the mobile station is registered as a visitor in the second country, for  
notifying said caller terminal of the registration of said mobile station before a  
connection between said caller terminal and said mobile station is established;  
and

a retaining unit for temporarily retaining establishing a connection between  
said caller terminal and said mobile station upon instruction from said caller  
terminal before the connection between said caller terminal and said mobile  
station is established at least until the user of said caller terminal selects one of a  
at least one subsequent operation at least including restarting establishing the  
connection between said caller terminal and said mobile station and terminating  
establishing the connection between said caller terminal and said mobile station.

However, Frey does disclose

a notification unit for referring to said information storing unit to detect,  
when said mobile station is called by a caller terminal within said first country,  
whether the mobile station is registered as a visitor station in the second country,  
and, if the mobile station is registered as a visitor in the second country, for  
notifying said caller terminal of the registration of said mobile station before a

Art Unit: 2617

connection between said caller terminal and said mobile station is established

(Col 8, lines 18-25; Col 6, 60-65); and

a retaining unit for temporally retaining establishing a connection between said caller terminal and said mobile station upon instruction from said caller terminal before the connection between said caller terminal and said mobile station is established at least until the user of said caller terminal selects one of the subsequent operation at least including restarting establishing the connection between said caller terminal and said mobile station and terminating establishing the connection between said caller terminal and said mobile station (Fig. 4; Col 7, line 59 – Col 8, line 42).

It would have been obvious to one ordinarily skilled in the art at the time of invention to combine Frey's disclosure to delegate charges correctly and to improve billing methodology, for improved billing accuracy.

Koster in view of Frey discloses all the particulars of the claim except for a mode changing unit that changes mode of a connection between said caller terminal and said mobile station from a conversation mode to a text-based mail sending mode upon receiving a request from said caller terminal,

wherein if said mode changing unit that changes from the conversation mode to the text-based mail sending mode upon receiving the request from said caller terminal, the notification system allows said caller terminal to send a text-based mail message to said mobile station.

However, Kung does disclose a mode changing unit that changes mode of a connection between said caller terminal and said mobile station from a conversation mode to a text-based mail sending mode upon receiving a request from said caller terminal (Col 10, lines 57-63; furthermore, Col 38, lines 13-34),

wherein if said mode changing unit that changes from the conversation mode to the text-based mail sending mode upon receiving the request from said caller terminal, the notification system allows said caller terminal to send a text-based mail message to said mobile station (Col 38, lines 13-34).

It would have been obvious to one ordinarily skilled in the art at the time of invention to be able to send text-base messages instead of talking to the called party if parties are not simultaneously available.

Regarding claim 18, Frey discloses the notification system as set forth in Claim 17, further comprising a mode changing unit that changes mode of a connection between said caller terminal and said mobile station from a conversation mode to a mail sending mode (to voicemail number) upon receiving a request from said caller terminal, wherein said subsequent operations further including changing the mode of the connection between said caller terminal and said mobile station from the conversation mode to the mail sending mode, and when the user of said caller terminal selects said changing the mode of the connection from the conversation mode to the mail sending mode, said mode changing unit changes the mode of the connection between said caller terminal

Art Unit: 2617

and said mobile station from the conversation mode to the mail sending mode (Col 9, lines 37-40).

Claims 18 further claims another said subsequent operation of claim 17, which states that only one selection of the subsequent operations are required for the system. Therefore, the subsequent operation claimed in 18 is not necessary to reject the claimed system.

Claim 20 is similarly rejected, as it claims another subsequent operation of claim 17, which only one subsequent operation is required by the system and was rejected in claim 17, rendering claim 20 inapplicable.

Regarding claims 19, Frey already disclosed in claim 17 that it is only necessary to select one of the subsequent operation; therefore, a subsequent operation of terminating establishing the connection between said caller terminal and said mobile station was disclosed by Frey (Fig. 4; Col 7, line 59 – Col 8, line 42), rendering claim 19 to be inapplicable.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chuck Huynh whose telephone number is 571-272-7866. The examiner can normally be reached on M-F 8am-5pm.

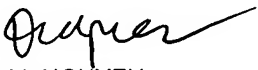


Art Unit: 2617

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on 571-272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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